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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,382	02/06/2002	James D. Pravetz	07844-494001	2559
21876	7590	07/26/2005		EXAMINER
FISH & RICHARDSON P.C. P.O. Box 1022 MINNEAPOLIS, MN 55440-1022			STORK, KYLE R	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/072,382	PRAVETZ, JAMES D.	
	Examiner	Art Unit	
	Kyle R. Stork	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 April 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-32 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

1. This final office action is in response to the amendment filed 26 April 2005 and the information disclosure statement filed 28 April 2005.
2. Claims 1-32 are pending. Claims 1 and 17 are independent claims and have been amended. The rejections of claims 1-32 under 35 U.S.C. 103 have been withdrawn as necessitated by the amendment.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 28 April 2005 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-3, 8, 10, 17-19, 24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (US 5917913, filed 4 December 1996), further in view of Lewis et al. (US 6233565, filed 13 February 1998, hereafter Lewis) and further in view of Fukuzaki (US 5948103, filed 25 February 1997).**

**Regarding independent claim 1,** Wang discloses a method for signing an electronic document (Wang approves transaction requests in the Abstracts, which are a type of electronic document), the method comprising: establishing an electronic signature appearance for an electronic signature (the format is established in col. 7, lines 5-10); determining a bounding region on the electronic document for the display of the electronic signature appearance (this is an inherent portion of displaying the signature in col. 10, line 65 —col. 11, line 15; and signing the electronic document with an electronic signature, the electronic signature associated with the electronic signature appearance (in col. 7, lines 1-20, the e-signature is completed and the format is pre-associated with it).

Wang fails to disclose at the time of signing an electronic document, previewing the electronic signature appearance in the bounding region. However, Lewis discloses a preview feature in col. 19, line 50—col. 20, line 10 which could obviously be generalized to previewing an electronic signature. It would have been obvious to one of ordinary skill in the art at the time of the invention to preview the electronic signature to ensure that its format is appropriate before signing a document with it.

Further, Wang fails to specifically disclose an electronic signature appearance comprising a visual manifestation of the electronic signature. However, Fukuzaki discloses an electronic signature appearance comprising a visual manifestation of the electronic signature (Figure 3G; column 7, line 63- column 8, line 3).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Wang and Lewis's method with Fukuzaki's

method, since it would have allowed a user to verify authenticity of the data (Fukuzaki: column 8, lines 38-40).

**Regarding dependent claim 2,** Wang discloses configuring the electronic signature appearance at the time of signing the electronic document (the format of the electronic signature is arrived at as the electronic signature is configured in col. 7, lines 5-15).

**Regarding dependent claim 3,** Wang, Lewis, and Fukuzaki fail to specifically disclose configuring the electronic signature appearance comprises interacting with a user signing the electronic document. However, it was notoriously well known in the art at the time of the invention that configuring a format often involves user interaction in order to ascertain the user's preferences regarding the format. It would have been obvious to one of ordinary skill in the art at the time of the invention to involve user interaction in configuring the format in order to ascertain the user's preferences regarding the format.

**Regarding dependent claim 8,** Wang discloses including in the electronic signature appearance textual elements automatically copied from a certificate of a user signing the electronic document (in col. 7, lines 10-15, data items are appended to the signature).

**Regarding dependent claim 10,** Wang, Lewis, and Fukuzaki fail to specifically disclose establishing an electronic signature appearance comprises interacting with a user to create an electronic signature appearance. However, it was notoriously well known in the art at the time of the invention that establish a format often involves user

interaction in order to ascertain the user's preferences regarding the format. It would have been obvious to one of ordinary skill in the art at the time of the invention to involve user interaction in establishing the format in order to ascertain the user's preferences regarding the format.

**Regarding independent claim 17**, it is a computer program product that performs the method of claim 1 and is rejected under similar rationale.

**Regarding dependent claim 18**, it is a computer program product that performs the method of claim 2 and is rejected under similar rationale.

**Regarding dependent claim 19**, it is a computer program product that performs the method of claim 3 and is rejected under similar rationale.

**Regarding dependent claim 24**, it is a computer program product that performs the method of claim 8 and is rejected under similar rationale.

**Regarding dependent claim 26**, it is a computer program product that performs the method of claim 10 and is rejected under similar rationale.

5. **Claims 4-7, 9, 11, 13, 20-23, 25, 27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang, Lewis, and Fukuzaki, and further in view of “User’s Guide: Microsoft Word”, Microsoft Corporation, Version 6.0, 1993-1994, hereinafter Microsoft Corporation.**

**Regarding dependent claim 4**, Wang, Lewis, and Fukuzaki fail to specifically disclose configuring the electronic signature appearance comprises: receiving user input activating controls for controlling textual and graphic elements included in the

electronic signature appearance. However, Microsoft Corporation on page 114 discloses user input activating controls for controlling textual and graphic elements present in text format (there are graphic elements as some fonts include graphic elements). As this is analogous art, it would have been obvious to one of ordinary skill in the art at the time of the invention to use controls for controlling textual and graphic elements present because it would have offered the user greater control over the various elements present in the format.

**Regarding dependent claim 5,** Wang, Lewis, and Fukuzaki fail to specifically disclose that the controls comprise one or more of checkboxes and buttons. However, Microsoft Corporation on page 114 discloses a dialog using checkboxes and buttons. It would have been obvious to one of ordinary skill in the art at the time of the invention to use checkboxes and buttons as in Microsoft Corporation's dialog on page 114 because these are user-friendly controls which facilitate the user interface.

**Regarding dependent claim 6,** Wang, Lewis, and Fukuzaki fail to specifically disclose that previewing the electronic signature appearance includes previewing a display in a configuration dialog box of the electronic signature appearance within the bounding region and the controls for controlling textual and graphic elements. However, Microsoft Corporation on page 114 discloses a region-bounded box which previews the format selected by the controls. It would have been obvious to one of ordinary skill in the art at the time of the invention to use Microsoft Corporation's preview within a bounding region in a dialog because this is a user-friendly setup which

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provides flexibility and gives the user a great deal of control over the format of the signature.

**Regarding dependent claim 7,** Wang, Lewis, and Fukuzaki fail to specifically disclose that previewing the electronic signature appearance includes displaying the electronic signature appearance within the bounding region on a display of the electronic document. However, Microsoft Corporation on page 114 discloses that the preview is in a bounded region. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a bounded region to display the signature as in Microsoft Corporation in Wang, Lewis, and Fukuzaki because this would be an aesthetically pleasing and space-efficient way to display the signature.

**Regarding dependent claim 9,** Wang, Lewis, and Fukuzaki fail to specifically disclose that establishing an electronic signature appearance comprises receiving user input selecting an electronic signature appearance from one or more existing electronic signature appearances. However, on page 212 of Microsoft Corporation, Microsoft Corporation sets forth a selection of appearances between multiple templates to provide a flexible choice of appearances. It would have been obvious to one of ordinary skill in the art at the time of the invention to select an electronic signature appearance from one or more existing electronic signature appearances to provide a flexible choice of appearances.

**Regarding dependent claim 11,** Wang, Lewis, and Fukuzaki fail to specifically disclose that establishing an electronic signature appearance comprises receiving an electronic signature appearance pre-configured by an author of the electronic document

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to be signed. However, on page 214 of Microsoft Corporation, Microsoft Corporation sets forth configuration of templates to provide a flexible choice of appearances. It would have been obvious to one of ordinary skill in the art at the time of the invention to select an electronic signature appearance from pre-configured templates to provide a flexible choice of appearances.

**Regarding dependent claim 13,** it reiterates limitations of claim 7 and is rejected under the same rationale.

**Regarding dependent claim 20,** it is a computer program product that performs the method of claim 4 and is rejected under similar rationale.

**Regarding dependent claim 21,** it is a computer program product that performs the method of claim 5 and is rejected under similar rationale.

**Regarding dependent claim 22,** it is a computer program product that performs the method of claim 6 and is rejected under similar rationale.

**Regarding dependent claim 23,** it is a computer program product that performs the method of claim 7 and is rejected under similar rationale.

**Regarding dependent claim 25,** it is a computer program product that performs the method of claim 9 and is rejected under similar rationale.

**Regarding dependent claim 27,** it is a computer program product that performs the method of claim 11 and is rejected under similar rationale.

**Regarding dependent claim 29,** it is a computer program product that performs the method of claim 13 and is rejected under similar rationale.

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6. **Claims 12, 14, 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang, Lewis, and Fukuzaki, further in view of Neff et al (USPN 6,751,780 B1—filing date 10/1/1998), hereinafter Neff.**

**Regarding dependent claim 12,** Wang, Lewis, and Fukuzaki fail to specifically disclose that determining a bounding region on the electronic document for the electronic signature appearance comprises interacting with a user signing the electronic document to establish the bounding region. However, Neff discloses establishing a boundary using drag and drop in col. 5, lines 35-55. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Neff with Wang, Lewis, and Fukuzaki because drag and drop would have enhanced their inventions because it is a user-friendly method for establishing bounding regions.

**Regarding dependent claim 14,** Wang, Lewis, and Fukuzaki fail to specifically disclose determining the bounding region on the electronic document for the electronic signature appearance comprises establishing a bounding region pre-set by an author of the electronic document. However, Neff discloses establishing a boundary using drag and drop in col. 5, lines 35-55. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Neff with Wang, Lewis, and Fukuzaki because drag and drop would have enhanced their inventions because it is a user-friendly method for establishing bounding regions. Further, it was notoriously well known in the art at the time of the invention that interactions such as establishing a boundary may be done in advance to save time at runtime. Therefore, it would have

been obvious to one of ordinary skill in the art at the time of the invention to use a pre-set bounding region in order to save time at runtime.

**Regarding dependent claim 28,** it is a computer program product that performs the method of claim 12 and is rejected under similar rationale.

**Regarding dependent claim 30,** it is a computer program product that performs the method of claim 14 and is rejected under similar rationale.

7. **Claims 15-16 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang, Lewis, and Fukuzaki, further in view of Rubin (USPN 6,654,009 B2—filing date 5/23/2001).**

**Regarding dependent claim 15,** Wang, Lewis, and Fukuzaki fail to specifically disclose determining an optimal layout of the electronic signature appearance based on the dimensions of the bounding region. However, Rubin in col. 3, lines 15-40 discloses finding a layout which is optimized based on the bounding region. It would have been obvious to one of ordinary skill in the art at the time of the invention to find a layout which is optimized based on the bounding region because it would be visually appealing.

**Regarding dependent claim 16,** Wang and Lewis fail to disclose determining optimal dimensions of the bounding region based on the electronic signature appearance. However, Rubin, in the Abstract, lines 1-15, discloses optimizing region size based on format. It would have been obvious to one of ordinary skill in the art at the time of the invention to optimize region size based on format because it would

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provide an ideal method of arranging entities two-dimensionally that would reflect the requirements of the format, which would be visually appealing, (see col. 1, lines 25-30).

**Regarding dependent claim 31,** it is a computer program product that performs the method of claim 15 and is rejected under similar rationale.

**Regarding dependent claim 32,** it is a computer program product that performs the method of claim 16 and is rejected under similar rationale.

***Response to Arguments***

8. Applicant's arguments with respect to claims 1-32, specifically claims 1 and 17, have been considered but are moot in view of the new ground(s) of rejection.

The Fukuzaki reference has been added to address the applicant's added limitation of, "an electronic signature appearance comprising a visual manifestation of the electronic signature on the electronic document (page 3, claim 1, lines 2-4; page 5, claim 17, lines 3-5)."

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle R. Stork whose telephone number is (571) 272-4130. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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